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| 09/323,636 | 06/01/1999 | JAMES E. BARRY | 8688.6808 | 9457 |

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| ART UNIT | PAPER NUMBER |
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2875

DATE MAILED: 04/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/323,636

Applicant(s)

JAMES E BARRY

Examiner

Y QUACH LEE

Group Art Unit

2875

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 1/16/2002
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1 to 33 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 1 to 16 is/are allowed.
- ☒ Claim(s) 17, 18, 20 to 23 and 25 to 33 is/are rejected.
- ☒ Claim(s) 19 and 24 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed January 16, 2002 have been fully considered but are moot in view of the new ground(s) of rejection.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).

There is no clear antecedent support for "at least a portion of the illumination member secured to the front half portion of the body member ... (claim 18) while the light from the illumination member is directed away from the body member (claim 17)" in the specification as originally presented.

There is no clear antecedent support for "a portion of the body member removed and at least a portion of the illumination member disposed therein (claim 19) while the light from the illumination member is directed away from the body member (claim 17)" in the specification as originally presented.

There is no clear antecedent support for "securing at least a portion of the illumination member to a front half portion of the body member ... (claim 23) while the illumination member illuminates a surrounding ground area (claim 22)" in the specification as originally presented:

There is no clear antecedent support for "removing a portion of the body member and disposing at least a portion of the illumination member therein (claim 24) while the illumination member illuminates surrounding ground area ... (claim 22)" in the specification as originally presented.

There is no clear antecedent support for "at least a portion of the illumination assembly adapted for attachment to a front half portion of the gasoline tank ... (claim 28) while the light from the illumination assembly is directed away from the gasoline tank to illuminate a ground area (claim 26)" in the specification as originally presented.

There is no clear antecedent support for "attaching the illumination assembly to a front half portion of the gasoline tank ... (claim 33) while the light from the illumination assembly is

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projected away from the motorcycle gasoline tank to illuminate a ground area ... (claim 32)" in the specification as originally presented.

Claim Objections

3. Claim 18 is objected to because of the following informalities: On line 3, the term "define" is improper in view of the previous term "is". It should be changed to --defined--. Appropriate correction is required.

4. Claims 18, 19, 23, 24, 28 and 33 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form.

Claims 18 and 19 do not further limit the subject matter of previous claim 17. In view of claim 17, an illumination member secured to the body member such that light from the illumination member is directed away from the body member which is directed to the third embodiment of drawing figures 7 to 10. However, claim 18 depends on claim 17 and recites that a front half portion and a back half portion and at least a portion of the illumination member is secured to the front half portion of the body member ... which are directed to the first and second embodiments of drawing figures 1 to 6, and claim 19 depends on claim 17 and recites a portion of the body member removed and at least a portion of the illumination member disposed therein which are directed to the first embodiment of drawing figures 1 to 4.

Claims 23 and 24 do not further limit the subject matter of previous claim 22. For instance, claim 22 recites ... so that the illumination member illuminates a surrounding ground area adjacent to the motorcycle ... which is directed to the third embodiment of drawing figures 7 to 10. However, claim 23 depends on claim 22 and recites securing at least a portion of the illumination member to a front half portion of the body member ... which is directed to the first and second embodiments of drawing figures 1 to 6, and claim 24 depends on claim 22 and recites ... removing a portion of the body member and disposing at least a portion of the illumination member therein ... which are directed to the first embodiment of drawing figures 1 to 4.

Claim 28 does not further limit the subject matter of previous claim 26. For instance, claim 26 recites ... such that light from the illumination assembly is directed away from the

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motorcycle gasoline tank or motorcycle hollow body shell to illuminate a ground area adjacent the motorcycle ... which is directed to the third embodiment of drawing figures 7 to 10.

However, claim 28 depends on claim 26 and recites that at least a portion of the illumination assembly is adapted for attachment to a front half portion of the gasoline tank ... which is directed to the first and second embodiments of drawing figures 1 to 6.

Claim 33 does not further limit the subject matter of previous claim 32. For instance, claim 32 recites ... such that light from the illumination assembly is projected away from the motorcycle gasoline tank or motorcycle hollow body shell to illuminate a ground area adjacent the motorcycle which is directed to the third embodiment of drawing figures 7 to 10. However, claim 33 depends on claim 32 and recites attaching the illumination assembly to a front half portion of the gasoline tank ... which is directed to the first and second embodiments of drawing figures 1 to 6.

Claim Rejections - 35 USC § 112

5. Claims 17, 20, 21, 26, 28 to 30, 32 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 17, 26 and 32, the language “light from the illumination member is directed away from the body member”, “light from the illumination assembly is directed away from the motor gasoline tank or motorcycle hollow body shell to illuminate a ground area adjacent the motorcycle”, and “light from the illumination assembly is projected away from the motorcycle gasoline tank ...” are considered to be misdescriptived and/or inaccurate. For instance, light itself is luminous flux and it is non-directional. In view the drawing and specification, without the reflective surface (314), the light is not directed away from the body member or projected away from the gasoline tank.

Claims 20, 21 and 29 depend on rejected claim 17 and as such are also rejected.

Claims 28 and 30 depend on rejected claim 26 and as such are also rejected.

Claim 33 depends on rejected claim 32 and as such is also rejected.

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Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 17, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helm (prior art previously cited).

Helm discloses a body member such as a gas tank (column 2, lines 48 to 49), an illumination member (12, 13, 17 ...) performed the function of a turn signal (12B, 13B ...) and secured to the body member such that light from the illumination member is directed away from the body member (note that the illumination member can be mounted to any metal walls with irregular shapes and irregular walls (column 4, lines 25 to 27) which indicate that the illumination member can be mounted on the end edge or the end of the gas tank body member together with the housing (figure 7, 13) of the illumination member, and as such, the light from the illumination member be directed away from the body member), and means (column 3, line 66) for energizing the illumination member. Note that the illumination member of Helm can be mounted on various gas tank (column 4, lines 17 to 18), therefore, to have the gas tank body member shaped as a motorcycle gasoline tank would have been an obvious matter of design choice which provides no unusual, unobvious, and/or unexpected result and is therefore deemed to fall within the purview of an ordinary engineering design technique to shape the gas tank body member in any shape as desired.

8. Claims 17, 18, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lichon et al. (prior art previously cited) in view of Helm (prior art previous cited).

Lichon et al. disclose a body member having a motorcycle gasoline tank (figure 1) having a front half portion closer to a front area of a motorcycle to which the body member is attached and a back half portion. However, Lichon et al. do not disclose an illumination member secured to the body member such that light from the illumination member is directed away from the body member.

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Helm discloses an illumination member (12, 13, 17 ...) performing the function of a turn signal (12B, 13B ...) and secured to a gas tank body member (11) or various gas tank (column 4, lines 17 to 18), and even can be mounted to any metal walls with irregular shapes and irregular walls (column 4, lines 25 to 27) which indicate that the illumination member can be mounted on any metal walls together with the housing (figure 7, 13) of the illumination member in such a manner that light from the illumination member be directed away from the body member, and means (column 3, line 66) for energizing the illumination member.

It would have therefore been obvious to one skilled in the art to mount the illumination member, in view of the teaching of Helm, to the front half portion of the body member of Lichon et al. for illuminating the adjacent area of the motorcycle to further transmit a warning signal to the surrounding.

9. Claims 22, 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lichon et al. (prior art previously cited) in view of Helm (prior art previous cited).

Lichon et al. providing a body member having a motorcycle gasoline tank (figure 1) having a front half portion closer to a front area of a motorcycle to which the body member is attached and a back half portion. However, Lichon et al. do not disclose the method of securing at least a portion of an illumination member to a front half of the body member so that the illumination member illuminates a surrounding ground area adjacent to the motorcycle.

Helm discloses the method of securing an illumination member (12, 13, 17 ...) to a gas tank body member (11) or various gas tank (column 4, lines 17 to 18), and even to any metal walls with irregular shapes and irregular walls (column 4, lines 25 to 27) which indicate that the illumination member can be secured to any metal walls together with the housing (figure 7, 13) of the illumination member in such a manner that light can illuminate the surrounding ground area adjacent to wherever the metal walls is located, and means (column 3, line 66) for energizing the illumination member.

It would have therefore been obvious to one skilled in the art to provide Linchon et al. with a method of securing the illumination member, in view of the teaching of Helm, to the front half portion of the body member of Lichon et al. for illuminating the adjacent ground area of the motorcycle to further transmit a warning signal to the surrounding for enhancing safety purpose.

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10. Claims 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lichon et al. (prior art previously cited) in view of Helm (prior art previous cited).

Lichon et al. disclose a motorcycle gasoline tank (figure 1) having a front half portion closer to a front area of a motorcycle to which the gasoline tank is attached. However, Lichon et al. do not disclose at least a portion of an illumination assembly adapted for attachment to a front half of the gasoline tank such that light from the illumination assembly is directed away from the gasoline tank to illuminate a ground area adjacent the motorcycle.

Helm discloses an illumination assembly (12, 13, 17) attached to a gas tank (11, column 2, line 49) or various gas tank (column 4, lines 17 to 18), and even to any metal walls with irregular shapes and irregular walls (column 4, lines 25 to 27) which indicate that the illumination assembly can be secured to any metal walls together with the housing (figure 7, 13) of the illumination assembly in such a manner that light from the illumination assembly is directed away from the irregular metal walls (i.e. the motorcycle gasoline tank) to illuminate the ground area adjacent to wherever the metal wall is located.

It would have therefore been obvious to one skilled in the art to attach the illumination assembly, in view of the teaching of Helm, to the front half portion of the gas tank of Lichon et al. for illuminating the ground area adjacent the motorcycle to further transmit a warning signal to the surrounding for enhancing safety purpose.

11. Claims 17, 27, 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamilton.

Hamilton discloses a non-transparent body member (2), an illumination member (5) secured to the body member and having a reflective member (6) for directing light from the illumination member away from the body member. Note that to have the body member shaped as a motorcycle gasoline tank would have been an obvious matter of design choice which provides no unusual, unobvious, and/or unexpected result and is therefore deemed to fall within the purview of an ordinary engineering design technique to shape the body member in any shape as desired.

12. Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lichon et al. (prior art previously cited) in view of Helm (prior art previous cited).

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Lichon et al. disclose a motorcycle gasoline tank (figure 1) having a front half portion closer to a front area of a motorcycle to which the gasoline tank is attached. However, Lichon et al. do not disclose at least a portion of an illumination assembly adapted for attachment to a front half of the gasoline tank such that light from the illumination assembly is projected away from the gasoline tank to illuminate a ground area adjacent the motorcycle.

Helm discloses a method of attaching an illumination assembly (12, 13, 17) to a gas tank (11, column 2, line 49) or various gas tank (column 4, lines 17 to 18), and even to any metal walls with irregular shapes and irregular walls (column 4, lines 25 to 27) which indicate that the illumination assembly can be secured to any metal walls together with the housing (figure 7, 13) of the illumination assembly in such a manner that light from the illumination assembly is projected away from the irregular metal walls (i.e. the motorcycle gasoline tank) to illuminate the ground area adjacent to wherever the metal wall is located.

It would have therefore been obvious to one skilled in the art to provide Lichon with a method of attaching an illumination assembly, in view of the teaching of Helm, to the front half portion of the gas tank of Lichon et al. for illuminating the ground area adjacent the motorcycle to further transmit a warning signal to the surrounding for enhancing safety purpose.

13. Claim 30 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.


14. Claims 1 to 16 are allowable over the prior art of record.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Y Quach Lee whose telephone number is 703-308-1939. The examiner can normally be reached on Tuesday and Thursday from 8:30 am to 4:30 pm.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Y. Q.
April 18, 2002


Y Quach Lee
Patent Examiner
Art Unit 2875